

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDRE M. GOINEAU
and JERRY N. KING

Appeal No. 2000-0922
Application 08/863,113

ORDER REMANDING TO EXAMINER

MAILED

AUG 29 2000

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

On September 14, 1998, Applicants filed an "APPEAL BRIEF UNDER 37 C.F.R. 1.192" (Paper No. 10). 37 CFR § 1.17(c) (Revised as of July 1, 1998) states:

(c) In addition to the fee for filing a notice of appeal, for filing a brief in support of an appeal:

. . . .

By other than a small entity - \$310.00

To date, Applicants' Appeal Brief is deficient \$310 in payment of fees and not in compliance with 37 CFR § 1.17(c).

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On December 23, 1998, the Examiner mailed his Answer (Paper No. 11). A review of the record indicates that this Answer is not signed. The Manual of Patent Examining Procedure (MPEP) § 707.09 (7th Ed, Rev. 1, Feb. 2000) states:

Signing by Primary or Other Authorized Examiner

Although only the original is signed, the word "Examiner" and the name of the signer should appear on the original and copies.

All letters and issues should be signed promptly.

Further MPEP § 1005 states:

Exceptions to Partial Signatory Authority

Examiners who are delegated partial signatory authority are expected to sign their own actions with the exception of **the following actions which require the signature of the primary examiner:**

. . . .

Examiner's answers on appeal (MPEP § 1208).

In its current state, the Examiner's Answer (Paper No. 11) is not in compliance with MPEP §§ 707.09 and 1005.

On page 5, in the first full paragraph of the Examiner's Answer (Paper No. 11 mailed December 23, 1998), the Examiner stated:

On page 4, paragraph 1 of the brief, appellant states that the rejection of claims 11-18 under 35 U.S.C. 112, second paragraph does not apply since claim 11 has been amended to correct an obvious

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omission. However, no after final amendment correcting such omission has been filed and therefore the rejection remains proper.

In response, Applicants' Reply Brief (Paper No. 12 filed January 11, 1999) attached a copy of an "amendment filed with the Brief" with a postcard receipt dated September 14, 1998 which addresses the examiner's rejection of "claims 11-18 under 112, second paragraph" (Answer, Paper No. 11, page 5). There is no indication in the record that this Amendment (Paper No. 12) has been considered.

Upon consideration of the entry of this Amendment (Paper No. 12), clarification is requested concerning the status of the examiner's rejection of claims 11-18 under 35 U.S.C. 112, second paragraph as stated on page 5 of his Answer (Paper No. 11).

If this Amendment (Paper No. 12) is entered in the official record, the language of claim 11 will differ from the current version listed in the Appendix to the Appeal Brief (Paper No. 10 filed September 14, 1998). The Appendix to the Appeal Brief (Paper No. 10) will no longer be in compliance with 37 CFR § 1.192(c)(9) (1997) which requires that the Appendix to the Appeal Brief contain a correct copy of the claims involved in the appeal.

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Accordingly, it is

ORDERED that the application is remanded to the Examiner for resolution of the following issues:

- the Appeal Brief fee of \$310.00 to be charged to Deposit Account No. 04-0500 as authorized by Applicants' application filing papers dated May 27, 1997 or otherwise, the appeal will be dismissed for failure to timely pay the Appeal Brief fee;

- ✓ signature of the Examiner's Answer (Paper No. 11 mailed December 23, 1998);

- ✓ mailing Applicants a copy of this Examiner's Answer (Paper No. 11 mailed December 23, 1998) with the word "Examiner" and his name;

- ✓ consideration of the Amendment (Paper No. 12 filed January 11, 1999);

- ✓ notification to Applicants **in writing** indicating the status of the Amendment (Paper No. 12);

- ✓ if appropriate, entry of the Amendment (Paper No. 12) filed January 11, 1999;

- ✓ clarification of the status of the rejection of claims 11-18 under 35 U.S.C. § 112, second paragraph;

- ✓ notification to Applicants to submit a corrected Appendix to the existing defective Appendix to the Appeal Brief (Paper

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No. 10), or for the examiner to issue a supplemental Examiner's Answer to officially correct the Appendix; and

- for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

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